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09/973,564	10/09/2001	Raymond Anthony Joao	RJ210	6010

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EXAMINER

NELSON, FREDA ANN

ART UNIT PAPER NUMBER

3639

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,564

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Freda A. Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/09/2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This is in response to a letter for a patent filed October 9, 2001 in which claims 1–20 were presented for examination. Claims 1-20 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 contains improper dependency.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 4-7, 12-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al (Patent Number 5,966,697).

In claims 1, 7, 12-13, 16, and 19-20, Ferguson et al. disclose that merchant A's computer includes a memory storage area for storing product data wherein product data may include pictures of the products, descriptions of the products, various options available (such as sizes and color), the prices of the products and shipping information

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(col. 4, lines 11, FIG. 2); a user computer, a checkout processor, and one or more merchant computers are interconnected via a network wherein the user first selects a merchant and receives (by a receiver), product information from the merchant (abstract); some goods, such as software, may be transmitted (by a transmitter) to the user via the computer network on which the user is shopping. In this situation, the goods may be transmitted to the user immediately following the successful transaction (col. 2, lines 58-61); and review processing may include calculating the total charges for products selected (col. 10, lines 1-4).

In claims 2 and 4, Ferguson et al disclose that the user is also presented with a running total for all items selected during this shopping session, in this case the total is \$46.20 (col. 12, lines 33-35; FIG. 9E).

In claim 5, Ferguson discloses that a user computer, a checkout processor, and one or more merchant computers are interconnected via a network (Internet)(abstract; FIG. 1).

In claim 6, Ferguson discloses that in table one, the selection data includes sufficient information to identify the products selected by a user, to calculate the total charges for an item, and to allow a user to modify the selection data at a later point within the shopping session (col. 7, lines 54-58).

In claim 9, Ferguson et al. does not disclose that the processor calculates at least one of maximum shipping costs, maximum handling costs, maximum taxes, maximum duties, maximum tariffs, and maximum insurance costs; at least one of waived shipping costs, waived handling costs, waived taxes, waived duties, waived tariffs, and waived insurance costs; and at least one of incremental shipping costs, incremental handling costs, incremental taxes, incremental duties, incremental tariffs, and incremental insurance costs, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitation of claim 9, a processor is disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

In claim 10, Ferguson et al. does not disclose that the processor calculates a minimum total transaction cost, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art

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apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitation of claim 10, a processor is disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

In claim 11, Ferguson et al. does not disclose that the processor at least of places, processes, and arranges an order to minimize at least one of said total transaction cost, a shipping cost, a handling cost, a tax, a duty, and an insurance cost, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 11, a memory device, a receiver, a processor, and a transmitter are disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

In claim 14, Ferguson et al. does not disclose that the receiver receives a user-defined maximum spending limit, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitation of 14, a receiver is disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

In claim 15, Ferguson et al. does not disclose that said processor processes said transaction in conjunction with said user-defined maximum spending limit, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitation of claim 15, a processor is disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

In claim 17, Ferguson et al. does not disclose that said apparatus can adjust an order to meet at least of a user-defined maximum spending limit and a minimum cost, however claims directed to an apparatus must be distinguished from the prior art in

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terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 17, a memory device, a receiver, a processor, and a transmitter are disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

In claim 18, Ferguson et al. does not disclose that said apparatus provides notification to a user at least one of when a total cost of a prospective transaction at least one of falls, and is reduced, to a certain total transaction amount, however claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 18, a memory device, a receiver, a processor, and a transmitter are disclosed in Ferguson et al. described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

3. Claims 3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson et al (Patent Number 5,966,697) in view of "From2.com Develops Revolutionary E-Commerce Solution For Tallard Technologies, Inc" (herein after referred to as "From2.com").

In claim 3, Ferguson et al. does not disclose that processor determines a running total cost of said transaction in real-time. From2.com discloses that with From2.com's Global Delivered Cost (GDC) Calculator, Tallard's manufacturers and master distributors will now be able to provide all-inclusive price and delivery quotes instantaneously at the point of purchase (page 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ferguson et al. to include the feature of From2.com in order to able to provide all-inclusive price and delivery quotes instantaneously at the point of purchase.

In claims 8, Ferguson et al disclose that merchant A's computer includes a memory storage area for storing product data wherein product data may include pictures of the products, descriptions of the products, various options available (such as

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sizes and color), the prices of the products and shipping information (col. 4, lines 11, FIG. 2).

Ferguson et al. does not disclose handling requirements and procedures. Ferguson et al. does not further disclose an insurance policy, premiums, charges and costs, for the at least one of good(s), product(s), and/or services(s). From2.com discloses that with From2.com's Global Delivered Cost (GDC) Calculator, Tallard's manufacturers and master distributors will now be able to provide all-inclusive price and delivery quotes instantaneously at the point of purchase, as well as comprehensive shipping services to all of their distribution channels (page 1). From2.com further discloses that the process begins with Tallard customer service personnel logging into From2.com's website wherein they are then prompted to input their customers' orders on the form provided; after the merchandise order has been placed, From2.com's GDC Calculator provides a complete delivery quote for any selected international destination including all freight, insurance, duties, taxes, customs clearance fees and other import charges with air and ocean shipping options; and the click of a mouse finalizes the transaction, setting in motion from start-to-finish, shipping, tracking and delivery (page 1). From2.com still further discloses that From2.com is linked directly into the merchant's website wherein it calculates all freight, insurance, duties, taxes, customs clearance fees and other import charges associated with shipping a product overseas, and gives customers instantaneous, accurate delivery quotes and air and ocean shipping options all prior to purchase (page 2). From2.com discloses that with From2.com's Global Delivered Cost (GDC) Calculator, Tallard's manufacturers and master distributors will now be able to provide all-inclusive price and delivery quotes instantaneously at the point of purchase (page 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Ferguson et al. to include the feature of From2.com in order to able to provide all-inclusive price and delivery quotes instantaneously at the point of purchase.

**Conclusion**

1) Bertash (Patent Number 6,928,416), which disclose a virtual client discounting pricing.

2) Hutchison et al. (US PG Pub. 2005/0192896), which disclose a method and apparatus for ordering goods, services, and content over an Internet network using a virtual payment account.

3) Kennedy et al. (Patent Number 6,055,519), which disclose a framework for negotiation and tracking of sale of goods.

4) Petters et al. (US PG Pub. 2001/0018672), which disclose a method and apparatus for facilitating the sale of goods over the Internet.

5) Kramer et al. (Patent Number 6,163,772), which disclose a virtual point of sale processing using gateway-initiated messages.

6) Amazon.com

7) Faisal, Syed, "eWonders.com, Inc. Launches All-Inclusive E-Shopping Guide to Help Consumers Find The Right Product at the Right price from the Right Place", Dec. 7, 1999, PR Newswire, pg 1.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

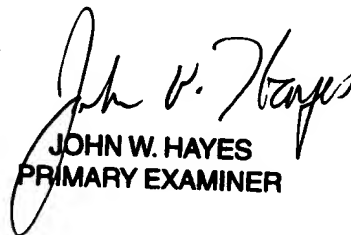



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FAN 09/19/05



JOHN W. HAYES  
PRIMARY EXAMINER